

ESTTA Tracking number: **ESTTA775622**

Filing date: **10/10/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86153946
Applicant	IOIP Holdings, LLC
Applied for Mark	OUT
Correspondence Address	GERARD T. GALLAGHER BARNES & THORNBURG LLP 100 N MICHIGAN ST STE 700 SOUTH BEND, IN 46601-1632 UNITED STATES jerry.gallagher@btlaw.com
Submission	Appeal Brief
Attachments	OUT - Appeal Brief.pdf(2084991 bytes)
Filer's Name	GERARD T. GALLAGHER
Filer's e-mail	jerry.gallagher@btlaw.com, michelle.horvath@btlaw.com
Signature	/Gerard T. Gallagher/
Date	10/10/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN RE THE APPLICATION OF:)
) APPEAL FROM:
IOIP Holdings, LLC)
) ATTORNEY: Janice McMorro
SERIAL NO.: 86/153,946)
) LAW OFFICE: 115
FILED: December 30, 2013)
)
FOR: OUT)

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S APPEAL BRIEF

I. Introduction

In the Final Office Action, the Examining Attorney refused registration of Applicant's mark on the grounds that the specimen submitted does not show the applied-for mark in the drawing in use in commerce. The Examining Attorney asserts that the mark in the drawing is OUT and that the mark on the specimen is DRAIN OUT. Applicant respectfully requests reversal of the refusal to register.

II. The Specimen Shows Use of the Mark OUT because that Term as Used on the Specimen Creates a Separate Commercial Impression.

Applicant respectfully submits that the specimen supports use of the mark OUT in commerce. A mark presented in combination with additional matter is registerable if it "presents . . . a separate and distinct commercial impression apart from any other matter with which the

mark is or will be used on the specimen." *Trademark Manual of Examining Procedure* §807.12(d).

Applicant respectfully submits that the use of OUT as shown on the specimen creates a commercial impression separate and apart from the term "drain." The word "drain" on the specimen is much smaller than the word "out." Additionally, the words "out" and "drain" are shown in different fonts. Specifically, the "O" in "out" includes a curved cutout portion, thereby distinguishing it from letters such as the "D" "R" and "A" in "drain" which have fully enclosed areas. It is clear from the specimen that the term "out" is clearly the dominant feature on the front of Applicant's product, it stands out considerably from all other text and clearly creates a separate commercial impression.

Applicant is also the owner of co-pending U.S. Trademark Application Serial No. 85/814,776 for the mark OUT used with other goods that are part of Applicant's OUT line of products. Registration was initially refused on the grounds that the specimen did not show the applied for mark in the drawing in use in commerce. In response, Applicant submitted photos showing the product in the specimen of use as it is seen by consumers on shelves at a Walmart located in South Bend, Indiana. (Exhibit A) In response, the Trademark Office issued a Notice of Acceptance of Statement of Use on September 16, 2016.¹ (Exhibit B) The specimen in the co-pending '776 Application uses the same font style and relative size differential as the specimen in the current application. Thus, it is respectfully submitted that the current specimen of use shows use of the mark OUT in commerce.

Furthermore, although not generic for the goods, "drain" is highly suggestive. The product is utilized by pouring it into a toilet bowl and flushing it through the toilet drain to treat the septic system. This promotes proper functioning of the septic system and prevents problems associated with improperly maintained septic systems, such as slow drains (including toilet drains). (See Exhibits A and B to Response to Office Action Dated August 14, 2015.)

¹ The Office Action Response and Notice of Acceptance of Statement of Use for the '776 Application were filed and issued, respectively, after the Notice of Appeal was filed for the present application. If necessary to have this additional evidence considered, Applicant hereby respectfully requests suspension of the present appeal and remand to the Examining Attorney for further examination pursuant to TTAB Manual of Procedure §1207.02.

Applicant respectfully submits that the highly suggestive nature of “drain” and the far more prominent use of “out” in a different font results in “out” creating a separate and distinct commercial impression. Thus, the specimen shows use in commerce of the mark OUT.

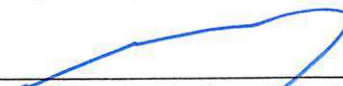
III. Conclusion

In light of the foregoing, it is clear that the term "out" creates a separate commercial impression from the term "drain" and that Applicant's mark is entitled to registration. *See, TMEP §807.12(d) and the cases cited therein, including: In re Big Pig, Inc.*, 81 U.S.P.Q.2d 1436 (TTAB 2006) (PSYCHO creates a separate commercial impression apart from additional wording and background design that appears on the specimen, where the word "PSYCHO" is displayed in a different color, type style and size, such that it stands out); *In re Raychem Corp.*, 12 U.S.P.Q.2d 1399, 1400 (TTAB 1989) (reversing refusal to register TINEL-LOCK, noting that part or stock number does not usually function as a source identifier, and the "fact that hyphens connect both the part number and the generic term to the mark does not, under the circumstances presented, create a unitary expression such that 'TINEL-LOCK' has no significance by itself as a trademark.").

It is respectfully submitted that Applicant's mark is in condition for registration. Accordingly, reversal of the refusal to register and issuance of a registration certificate is respectfully solicited. If any fees are due, please charge them to Barnes & Thornburg's Deposit Account No. 100435 (46774. 57455).

Dated: 10/10/16

Respectfully submitted,



Gerard T. Gallagher, Reg. No. 39,679
BARNES & THORNBURG LLP
700 1st Source Bank Center
100 North Michigan Street
South Bend, IN 46601-1632
Telephone: 574-233-1171

TABLE OF AUTHORITIES

CITE

PAGE NO.

<i>In re Big Pig, Inc.</i> , 81 U.S.P.Q.2d 1436 (TTAB 2006)	3
<i>In re Raychem Corp.</i> , 12 U.S.P.Q.2d 1399, 1400 (TTAB 1989).....	3

STATUTES

TMEP §807.12(d)	2, 3
-----------------------	------

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85814776
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/85814776/large
LITERAL ELEMENT	OUT
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	

REMARKS

I. The Office Action

In the outstanding Office Action, the Examining Attorney refused registration of Applicant's mark in Class 1 on the grounds that the specimen submitted does not show the applied-for mark in use in commerce in connection with any of the goods listed in the application in Class 1. The Examining Attorney also refused registration of Applicant's mark in Class 3 on the grounds that the specimen does not show the applied for mark in the drawing in use in commerce. The Examining Attorney asserts that the mark in the drawing is OUT and that the mark on the specimen is IRON OUT.

II. Class 1

Applicant respectfully submits that the specimen of use previously provided shows use of the mark in connection with "chemical compound for use in removing foreign matter from water softeners" in Class 1. Applicant submits herewith as exhibit A an enlarged view of a portion of the bottle shown in the specimen of use. The bottle clearly shows that the product is for use in water softeners. In water softeners, the product cleans the mineral bed and removes iron build-up. It also changes rust and iron into a clear solution that easily rinses away. Thus, the product does in fact remove foreign matter (namely, iron and rust build up) from water softeners.

III. Class 3

Applicant respectfully submits that the specimen supports use of the mark OUT in commerce. A mark presented in combination with additional matter is registerable if it "presents . . . a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen." *Trademark Manual of Examining Procedure* §807.12(d).

Applicant respectfully submits that the use of OUT as shown on the specimen creates a commercial impression separate and apart from the term "iron." Applicant submits herewith as Exhibits B and C photos showing the product in the specimen of use as it is seen by consumers on shelves at a Walmart located in South Bend, Indiana. It is clear from Exhibits B and C that the term "out" is clearly the dominant feature on the front of Applicant's products, it stands out considerably from all other text and clearly creates a separate commercial impression.

EXHIBIT A

Furthermore, the term "iron" is suggestive as applied to the goods shown in the specimen. Rust is an iron oxide. Rust stain removal is one of the functions of the product. Suggestive terms are far less likely to contribute to the commercial impression created by a mark.

Applicant also notes that the word "iron" on the specimen is much smaller than the word "out" and that the words are shown in different fonts. Specifically, the "O" in "out" includes a curved cutout portion, thereby distinguishing it from the letters "O" and "R" in "iron," which have fully enclosed areas.

In light of the foregoing, it is clear that the term "out" creates a separate commercial impression from the term "iron" and that Applicant's mark is entitled to registration. *See, TMEP §807.12(d) and the cases cited therein, including: In re Big Pig, Inc.*, 81 U.S.P.Q.2d 1436 (TTAB 2006) (PSYCHO creates a separate commercial impression apart from additional wording and background design that appears on the specimen, where the word "PSYCHO" is displayed in a different color, type style and size, such that it stands out); *In re Raychem Corp.*, 12 U.S.P.Q.2d 1399, 1400 (TTAB 1989) (reversing refusal to register TINEL-LOCK, noting that part or stock number does not usually function as a source identifier, and the "fact that hyphens connect both the part number and the generic term to the mark does not, under the circumstances presented, create a unitary expression such that 'TINEL-LOCK' has no significance by itself as a trademark.').

IV. Conclusion

An earnest attempt has been made to respond fully and completely to the outstanding Office Action. It is respectfully submitted that Applicant's mark is in condition for registration and issuance of a registration certificate is respectfully solicited. If any fees are due, please charge them to Barnes & Thornburg's Deposit Account No. 100435 (46774.57112).

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1995873130-20160906144257810755_OUT - Exhibits A-C.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT16\IMAGEOUT16\858\147\85814776\xml29\ROA0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\858\147\85814776\xml29\ROA0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\858\147\85814776\xml29\ROA0004.JPG
DESCRIPTION OF EVIDENCE FILE	Exhibits A-C, photographs

SIGNATURE SECTION

RESPONSE SIGNATURE	/Gerard T. Gallagher/
SIGNATORY'S NAME	Gerard T. Gallagher
SIGNATORY'S POSITION	Attorney, Indiana bar member
SIGNATORY'S PHONE NUMBER	574-237-1156
DATE SIGNED	09/06/2016
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Tue Sep 06 14:51:13 EDT 2016
TEAS STAMP	USPTO/ROA-XXX.XX.XX.XXX-2 0160906145113013708-85814 776-550dcc80f67119d3701d1 97bc3d0bd722b49dfba58b7ad 6919784e14b4da6f2-N/A-N/A -20160906144257810755



EXHIBIT A





EXHIBIT C

From: TMOfficialNotices@USPTO.GOV
Sent: Friday, September 16, 2016 00:12 AM
To: jerry.gallagher@btlaw.com
Subject: Official USPTO Notice of Acceptance of SOU: U.S. Trademark SN 85814776: OUT: Docket/Reference No. IRO-XXX

NOTICE OF ACCEPTANCE OF STATEMENT OF USE

U.S. Serial Number: 85814776
Mark: OUT
Owner: IOIP Holdings, LLC
Docket/Reference Number: IRO-XXX

The USPTO has accepted the Statement of Use filed for the trademark application identified above. The mark will now register and the registration certificate will issue in due course barring any extraordinary circumstances.

To check the status of the application, go to http://tsdr.uspto.gov/#caseNumber=85814776&caseType=SERIAL_NO&searchType=statusSearch or contact the Trademark Assistance Center at 1-800-786-9199. Please check the status of the application at least every three (3) months after the application filing date.

To view this notice and other documents for this application on-line, go to http://tsdr.uspto.gov/#caseNumber=85814776&caseType=SERIAL_NO&searchType=documentSearch. NOTE: This notice will only become available on-line the next business day after receipt of this e-mail.

For further information, including information on filing and maintenance requirements for U.S. trademark applications and registrations and required fees, please consult the USPTO website at <http://www.uspto.gov/trademarks/> or contact the Trademark Assistance Center at 1-800-786-9199.

EXHIBIT B
